In The

Supreme Court of the United States

NO. 818

OCTOBER TERM, 1960

THE COLD METAL PROCESS COMPANY, ET AL.,

Petitioners,

v.

THE UNION NATIONAL BANK OF YOUNGSTOWN, OHIO, TRUSTEE, ET AL.,

Respondents.

THE REISS COMPANY, ET AL.,

Petitioners,

v.

THE COLD METAL PROCESS COMPANY, ET AL.,

Respondents.

REPLY BRIEF FOR PETITIONERS

[redacted]

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THE COLD METAL PROCESS COMPANY and THE UNION NATIONAL BANK OF YOUNGSTOWN, OHIO, TRUSTEE, Petitioners,

v.

E. W. BLISS COMPANY and GREER STEEL COMPANY, Respondents.

REPLY BRIEF FOR PETITIONERS

Respondents' admissions show that the petition should be granted:

(a) Having no answer to the points relied upon by petitioners, respondents resort to the assertion that the basic erroneous holding was "clear *dicta*." They then admit error by the Court below (Br. 8) when they say that the "comments" of the Court below

> "also show a failure to distinguish the facts in the various opinions of this Court with respect to the effect of the breadth of a patentee's invention upon his right to hold subsequent developments as infringements."

(b) Respondents also admit (Br. 11) that where (as is clearly the case here) the patentee's contribution

> "points out a whole new area, the fact that another subsequently discovers a variant [Morgoil bearings] within that area [the new combination] may not

relieve him of his obligation to the patentee." (Bracketed matter added)

That the inventions here have developed a whole new area and occupy a position among the great inventions is clear from the holdings of the Courts below that they filled a "long-existing" demand in the steel industry, that they "revolutionized" the manufacture of thin sheets and strip, that they removed a long-standing "technological block" in the industry and that they should be given a liberal construction.* Morgoil bearings surely are no more than a "variant" within the area of the new combination.

Contrary to respondents' assertions, the opinions below make it clear that the real basis for the erroneous holding on non-infringement is that discussed in the petition. This is necessarily so because the Court expressly found (233 F.2d 841):

"* * * the Morgoil bearings perform all the functions of caged roller bearings, * * *."

This finding, as a matter of law, requires a holding of infringement under the doctrine of the *Morley* case (129 U.S. 263) and the other cases said by the Court below to have been overruled by this Court in the *Halliburton* case (329 U.S. 1).

It is correct, as the Court below stated, that there are real structural differences and operational differences between Morgoil bearings and roller bearings,**

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* Respondents' attempt to equate the revolution in the art to mere "commercial success" flies in the face of the expressed bases for the holding that the inventions had revolutionized the art (see 123 F. Supp. 529).

** This was also true in *Morley* (129 U.S. 263, 285, 289, 290) and in *Cochrane v. Deener* (94 U.S. 780, 789-90).

but the question is not whether these bearings, *as bearings,* are equivalent to each other; it is whether, *in the combination claimed by the patentee,* they perform the same functions. This they do, as the Courts below held, and this requires, as a matter of law under this Court's decisions, a holding of infringement of the combination claimed, namely, small work rolls, large backing rolls and antifriction mountings for the backing rolls.

Respondents' attempt to relegate the real basis of the holdings below on this Morgoil bearing issue to the status of "clear *dicta*" and their emphasis upon the holding that the two bearings (roller and Morgoil)—as bearings—are not equivalent because of differences in structure and operation would *indicate* that there were two grounds for the non-infringement holding below. Judge Levin's opinion in *Republic* does not support this; and, as we view it, neither does that of the Court of Appeals in either *Republic* or this case. Assuming, *arguendo,* that there were two grounds, this second ground is wrong as a matter of law for mere non-equivalency of the Morgoil and roller bearings as bearings is not sufficient since the real question is whether, *in the combination,* they perform the same functions; and on this the Courts have held, on undisputed evidence and concessions, that they do.* Hence, as a matter of law,

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* In *Cochrane v. Deener,* 94 U.S. 780, 789-90, this Court said:

> "Though some of the corresponding parts of the machinery, designated in this combination, are not the same in point of form in the two bolting apparatuses, and separately considered, could not be regarded as identical or conflicting, yet having the same purpose *in the combination,* and effecting that purpose in substantially the same manner, they are the equivalents of each other in that regard." (Emphasis added)

under this Court's decisions in the *Morley, Machine Co.* and *Cochrane* cases, which the Court below refused to follow, a holding of infringement should have followed ineluctably.

The petition should be granted and the decision below, on the issue in question, should be reversed on the authority of the *Morley* case.

Respectfully submitted,

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